

## REMARKS

### **I. Introduction**

Claims 1 and 3 are pending in the above application.

Claim 1 stands rejected under 35 U.S.C. § 102(e).

Claim 3 stands rejected under 35 U.S.C. § 103(a).

### **II. Amendments**

Claims 2 and 4-15 have been cancelled without prejudice or disclaimer.

Claim 1 has been amended to incorporate the limitations of claims 3, 5 and 7.

Claim 3 has been rewritten into independent form and amended to incorporate the limitations of claims 1, 6 and 8. Each of claims 1 and 3 have been further amended to recite “g) group control table registering plural telephone numbers in one group number.” Support for the above amendment may be found at least at page 9, line 20 through page 10, line 20 of the specification. Claim 1 has also been amended to change “response messages” to –response message—as requested by the Examiner. Accordingly, claim 1 as amended, is believed to be sufficiently definite within the meaning of 35 U.S.C. § 112 ¶ 2.

No new matter has been added.

### **III. Prior Art Rejections**

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Aktas et al. (U.S. Patent No. 6,459,776) (hereafter “Aktas”).

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Aktas in view of Tachell et al. (U.S. Patent No. 6,160,877) (hereafter “Tachell”).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int’l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the *claimed invention* where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). See also MPEP 2143.01.

As acknowledged by the Office action, Aktas does not disclose an audio storage apparatus that contains a combination of elements including “a group control table registering plural telephone numbers in one group” as now recited in amended claim 1. Office action, page 4. Accordingly, Aktas does not anticipate amended claim 1.

Neither Aktas nor Tachell, taken alone or in combination, disclose or suggest the combination of elements recited in amended claims 1 and 3. Aktas does not disclose all of the elements of amended claim 1 as discussed above. Tachell merely discloses a system of providing a greeting corresponding to a caller number of a calling party. Particularly, Tachell discloses to identify a called party according to the name of the

called party, *e.g.* “if a normal call ... the requested name is in the contract database” (col. 15, lines 27-38). Tatchell also discloses a command for programming a contact database (col. 15, line 49 through col. 16, line 15 – “contact database programming ... the caller log”) and to add, change, look up, and review contacts to the database (col. 16, lines 16-47).

However, neither Aktas nor Tatchell, taken alone or in combination, disclose or suggest the limitations of amended claims 1 and 3 as a whole. More particularly, neither Aktas nor Tatchell, taken alone or in combination, disclose or suggest an audio storage apparatus which includes: “a response message control table for assigning each caller information with each of a plurality of the response messages for each of a plurality of mailboxes,” (*e.g.* a plurality of mail boxes which may be assigned and each mailbox including a response message corresponding to a plurality of caller numbers); when it is judged that a response message corresponding to the caller information detected by the caller information detector is not assigned, reproduces a response message not assigned to the caller information (*e.g.* each mailbox includes a response message not corresponding to a caller number; and a group control table registering plural telephone numbers in one group (*e.g.*, a configuration which allows assigning a plurality of caller numbers to individuals callers and for a group).

As neither Aktas nor Tatchell, taken alone or in combination, disclose or suggest at least the above features of amended claims 1 or 3, neither Aktas nor Tatchell, taken alone or in combination produce the claimed invention of amended claims 1 or 3. Accordingly, neither Aktas nor Tatchell, taken alone or in combination, render amended claims 1 or 3 as obvious.

#### **IV. Conclusion**

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,  
MCDERMOTT, WILL & EMERY



Lawrence T. Cullen  
Registration No. 44,489

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 MEF:MWE  
**Date: October 18, 2004**  
Facsimile: (202) 756-8087  
WDC99 989840-2.043890.0471